

REMARKS

The only pending claims in this application are claims 10-26 and 29-31, of which claim 10 is the only independent claim. The remaining dependent claims depend either directly or indirectly from independent claim 10.

Applicants note and appreciate that the Section 112, paragraph 2 rejection has been withdrawn as to claims 19 and 26. In the Office Action, claims 10-14, 17, 18-25 and 29-31 were rejected under 35 U.S.C. Section 102(a) as being anticipated by Matsui et al., U.S. Patent No. 6,352,503 (hereinafter known as the "Matsui '503 reference"). Claims 15, 16 and 26 were rejected under 35 U.S.C. Section 103 as being obvious in view of the Matsui '503 reference.

As to the Section 102 and 103 rejections, applicants respectfully request reconsideration. As applicants have previously pointed out, the Matsui '503 reference is not a prior art reference against the current application, and the priority under 35 U.S.C. § 119 does not make Matsui prior art as of that date.

The pertinent authorities have consistently held that foreign priority dates under Section 119(a)-(d) cannot be used to defeat another's attempt to obtain a patent. Specifically, the Court of Custom and Patent Appeals decision in In re Hilmer, 359

F.2d 859, 149 USPQ 480 (CCPA 1966) (Hilmer I), is directly on point.

In Hilmer I, the applicant filed an application which claimed priority to an earlier German application. The application was rejected on the basis of a U.S. Patent reference to Habicht which claimed priority to an earlier Swiss application that was filed prior to the German application's filing date. The U.S. filing date of Habicht was later than the application's German priority date. The CCPA held that the U.S. reference's foreign priority date could not be used to defeat patentability of the application. In other words, the Swiss priority date could not be relied upon to support a Section 102(e) rejection, and the CCPA reversed the rejection. In contrast, the applicant was entitled to rely upon its own Section 119(a)-(d) foreign priority date to overcome the rejection based on the U.S. reference. Since the German priority date was earlier than the reference's U.S. filing date, the rejection was reversed.

Based on the rule set forth in Hilmer, there is an important distinction to be made between (1) the earliest effective date which may be relied upon for a U.S. patent claiming foreign priority in the context of prior art under Section 102(e) and (2) the earliest effective date which may be relied upon for a U.S. patent claiming foreign priority in the context of obtaining a patent by antedating a prior art reference.

The Hilmer rule is also set forth in the MPEP Section 2136.03 (I), entitled "Critical Reference Date" which states that:

Foreign applications' filing dates that are claimed (via 35 U.S.C. 119(a)-(d), (f) or 365(a)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may not be used as 35 U.S.C. 102(e) dates for prior art purposes....Therefore, the foreign priority date of the reference under 35 U.S.C. 119(a)-(d) (f), and 365(a) cannot be used to antedate the application filing date. In contrast, applicant may be able to overcome the 35 U.S.C. 102(e) rejection by proving he or she is entitled to his or her own 35 U.S.C. 119 priority date which is earlier than the reference's U.S. filing date. (Citing Hilmer I) (Emphasis in original)

In the current application, the Matsui '503 reference has a U.S. filing date of July 15, 1999, which is not earlier than applicant's earliest effective filing date of May 20, 1999. Based on the Hilmer rule, the two Japanese priority applications' filing dates of July 17, 1998 and July 21, 1998, cannot be relied upon to establish the Matsui references as prior art. Rather, the Matsui '503 reference's earliest effective date as a prior art reference is July 15, 1999 and, thus, the Matsui '503 reference is not prior art and cannot form the basis for rejection.

No Rejection Under Sections 102(a) or 102(e) Can Stand

The rejection under Section 102(a) was in error because Section 102(a) is not applicable. Section 102(a) would only apply if the Matsui '503 reference was issued or was published (or the Matsui Japanese applications were issued or were

published) prior to the applicants' date of invention.

Applicants' date of invention is at least as early as the May 20, 1999, priority date.

Section 102(a) does not apply because the Matsui U.S. or Japanese applications were not patented or published prior to applicants' May 20, 1999 date. The Matsui '503 reference was first published upon issuance which occurred on March 5, 2002, which was not earlier than the May 20, 1999, priority date. Both Japanese applications were published on February 2, 2000, which also occurred after the May 20, 1999, priority date. Thus, they do not qualify as prior art under Section 102(a).

Section 102(e) Also is Not Applicable


Section 102(e) would only apply if the Matsui '503 reference was granted on an application which was filed in the United States before the applicants' date of invention. It (the Matsui patent) was not, for the reasons set forth above. The applicant's earliest effective filing date is May 20, 1999, and the earliest date the Patent Office can rely upon when using Matsui as prior art is July 15, 1999. Matsui is not prior.

Accordingly, applicants respectfully request that the Examiner withdraw the rejection of claims 10-26 and 29-31. Reconsideration and allowance are respectfully requested.

Respectfully submitted,

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